

## **REMARKS**

Claims 2, 3, and 5–8 are pending in the application. In the Office action dated May 12, 2009, claims 2, 3, and 5–8 were rejected. Responsive to the Office action, Applicant has amended claim 8. In view of the above amendment and the following remarks, Applicant requests reconsideration of the application under 37 C.F.R. § 1.111.

### ***Rejections under 35 U.S.C. §§ 102 and 103***

Claims 6–8 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over the newly cited Sato reference (U.S. D381,361).

Claims 2, 3, and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato as applied to claim 8 above, and further in view of Burleigh et al. (U.S. Patent no. 2,310,835).

Applicant traverses the rejections.

### **The claimed invention**

Independent claim 8 currently recites a clip for clamping sheets of paper, plastic, metal, and other materials at the sheet corners or sides, where the clip includes two limbs, and a pre-tensioned back configured to apply a force to the limbs.

In addition, the recited clip is configured to be U-shaped, with the limbs parallel to each other when in a relaxed state. Each limb include a small inward fold of less than 90 degrees, and each inward fold defines a fold line that is disposed at an acute angle with respect to the pre-tensioned back.

The recited clip is configured so that the sheets may be clamped between the limbs by virtue of the force applied by the pre-tensioned back; and the clip includes

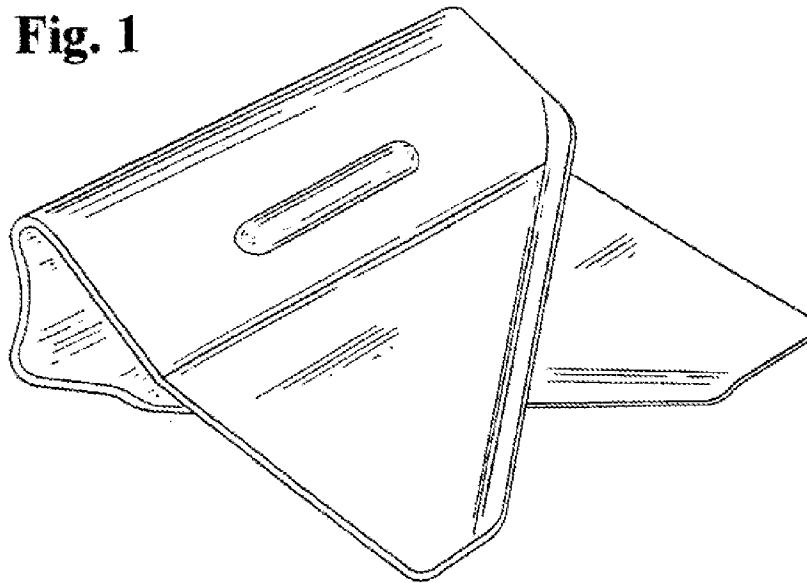
metal or high-strength plastic or wood or compressed cellulose.

Sato

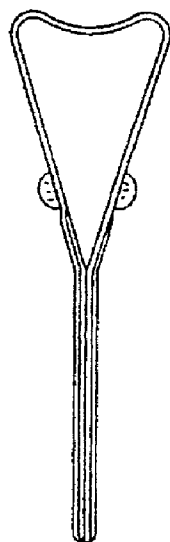
The Sato reference discloses a design for a paper clip, as shown below in Figs.

1, 3, and 6 of Sato:

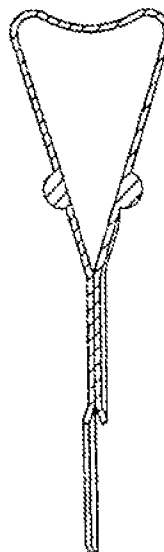
**Fig. 1**



**Fig. 3**



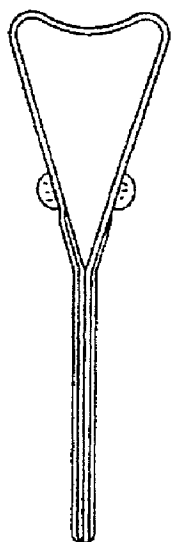
**Fig. 6**



In citing the Sato reference, the Examiner is disregarding the recited elements of claim 8, and/or applying an inappropriately broad interpretation to such elements.

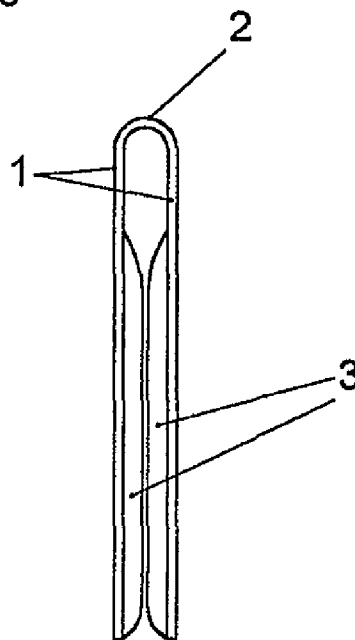
Claim 8 recites a clip that is "configured to be U-shaped with the limbs parallel to each other in a relaxed state". The Examiner states that the back of the clip of Sato is U-shaped, but this is not what claim 8 recites. Claim 8 is directed to a clip that is configured to be U-shaped. Furthermore, and to further reinforce that the clip is U-shaped, the limbs of the claimed clip are parallel. The Examiner asserts that the limbs of Sato are parallel in the region where they touch each other, but this is not an element of claim 8, which recites a clip that is U-shaped, with limbs that are parallel. As shown in the comparison below, the clip of Sato is clearly not U-shaped.

**Fig. 3**



**Sato clip**

**Fig. 2**



**Exemplary clip of claim 8**

Claim 8 is clearly directed to a U-shaped clip where the limbs of the clip are parallel to each other in its relaxed state. Sato simply fails to disclose a clip including these elements.

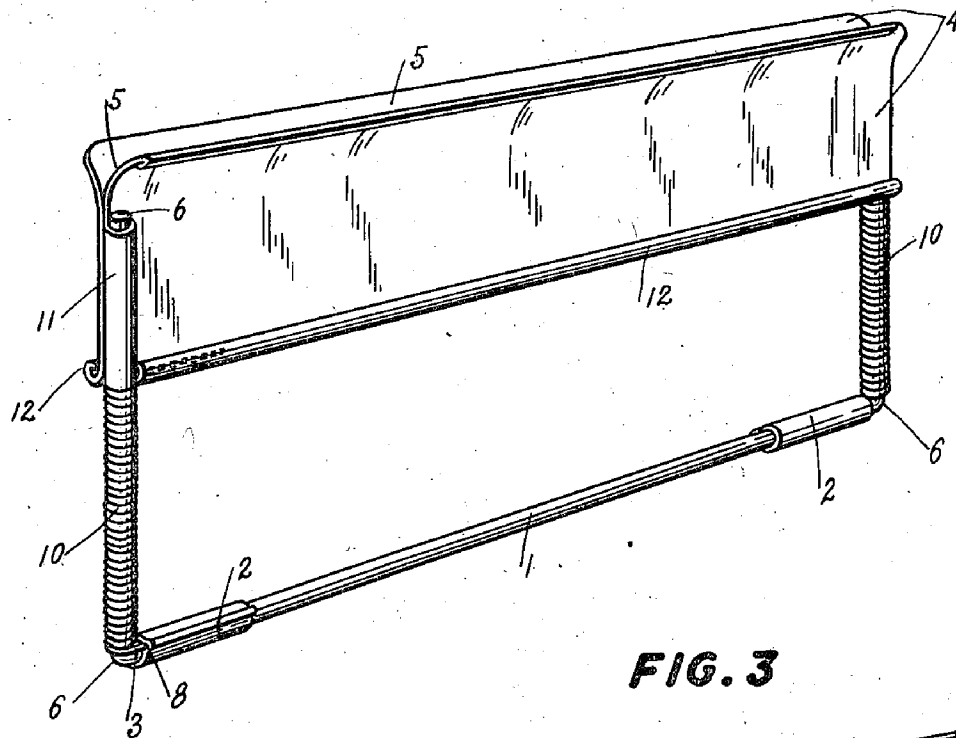
Furthermore, claim 8 recites a clip where each limb includes "a small inward fold of less than 90 degrees". The limbs of Sato include two outward folds: The first at the point where the limbs come into contact, and the second along the angled edge of each limb. The Sato clip utterly fails to display such an inward fold.

Applicant respectfully suggests that it is clear that the Sato reference fails to disclose each and every element of claim 8, as it is set out in the claim, and therefore claims 6–8 are not anticipated by Sato. Applicant therefore respectfully requests the withdrawal of the rejection of claims 6–8 under 35 U.S.C. § 102.

With respect to the rejections of claim 6–8 and 2, 3, and 5 under 35 U.S.C. § 103(a), Applicant suggests that the Examiner has failed to establish the *prima facie* obviousness of the rejected claims.

With respect to Sato, as discussed above, Sato fails to disclose each and every element of the rejected claims. Furthermore, since Sato discloses a clip whose limbs incorporate two outward folds, and no inward folds, Applicant suggests that Sato would in fact lead one of skill away from a clip having limbs which incorporating an inward fold, as recited in claim 8.

Revisiting the teachings of Burleigh, Applicant notes that the Burleigh clip includes grippers having upper edge that are "flared outwardly", as clearly shown in Fig. 1 of Burleigh, below:

**FIG. 1****FIG. 3**

The clip of Sato incorporates two outward folds, while the Burleigh clip exhibits outwardly flared edges. Neither reference discloses a clip having limbs that exhibit an inward fold, and the cited references, either considered individually or in combination, fail to provide any incentive to modify the disclosed designs so as to arrive at a clip having limbs that exhibit an inward fold. Where a proposed modification changes the principle of operation of a reference, there can be no motivation to modify the reference (MPEP § 21043.01).

For at least the above reasons, Applicant requests the withdrawal of the rejection of claims 6–8 and 2, 3, and 5 under 35 U.S.C. § 103(a).

### ***Amendments to the Claims***

The present application has been pending for more than three years. Applicant has proven willing to amend the pending claims in order to more particularly define the invention. Nevertheless, the previous Office action is the **sixth** action received in this application, and cites references that were either previously cited, or that appear to be no more than cumulative to previously cited references.

In the interest of obtaining allowance of the claims, and in hopes of avoiding a lengthy and expensive Appeals process, Applicants have again amended claim 8 to even further distinguish the recited clip over the cited references. Claim 8, as amended, is directed to a U-shaped clip having limbs parallel to each other in a relaxed state, each limb including a small inward fold defining a fold line that is disposed at an acute angle with respect to the back of the clip, and each fold line being parallel to the other.

In view of the above amendments and remarks, Applicant believes that the application is again in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims.

The Commissioner is hereby authorized to charge or credit any deficiencies or over-payments to Deposit Account No. 11-1540 which may be required in connection with this filing. Please contact the undersigned agent of record with any questions regarding this submission.

CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being transmitted electronically via the United States Patent and Trademark Office's EFS-Web System on September 14, 2009.

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